

REMARKS/ARGUMENTS

Amendments

The specification is amended to correct the page numbering and several oversights that are grammatical, clerical or typographical in nature. Additionally, the claims are modified in the amendment. More specifically, claims 1, 10, 12, 14, 15, 18 and 21 have been amended; claims 9, 20, and 23 have been cancelled; and no new claims have been added. Therefore, claims 1-8, 10-19, and 21-22 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

Initial Matter

As an initial matter, the Applicants respectfully note that the Office failed to initial the non-patent literature documents listed on sheet 8 of the Information Disclosure Statement. The Applicants assume that this was a clerical error and the cited documents have been duly considered. Confirmation of the same is respectfully requested.

Double Patenting

Claims 1-23 stand as rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/046,654 and claims 1-31 of copending Application No. 10/045,633. Applicants respectfully disagree with this rejection, especially in light of the amendments. Reconsideration of this rejection is respectfully requested.

Claim Objections

Claims 9, 20 and 23 are objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Although the Applicants do not necessarily agree with these rejections, these claims are canceled in the interest of expediting

allowance of the other claims which have allowable subject matter. Reconsideration of this objection is respectfully requested.

Markush Claims

Claims 1, 10, 12, 14, 15, 18 and 21 appear to be Markush claims. The claims have been amended to incorporate the more traditional Markush language of "consisting of" in place of "including" as the Examiner suggests. Withdrawal of this rejection is respectfully requested.

35 U.S.C. §102 Rejection, Doggett et al.

The Office Action has rejected claims 10-14 and 16-23 under 35 U.S.C. §102(b) as being anticipated by the cited portions of U.S. Patent No. 5,677,955 to Doggett et al. (hereinafter "Doggett"). Independent claims 10 and 21 are believed to distinguish over the cited portions of Doggett because limitations in these claims are neither taught nor suggested by Doggett. More specifically, Doggett does not teach or suggest the use of an internally managed stored-value fund as is required by amended claim 10. Nor does Doggett teach or suggest the use of a plurality of second handlers for pay-out as is required by amended claim 21. For at least these reasons, the Applicants respectfully request reconsideration of the rejection to claims 10-14, and 16-23.

Generally, claims 10 and 21 provide methods for transferring a credit amount out of an online system using a payment instrument. In one embodiment, pay-out instructions are received at a server computer from a wide-area computer network coupled to a payor. Credit is then transferred from a first handler associated with the payor to the online system. This credit is stored in a temporary stored value fund which is managed internally by the online system. Pay-out instructions are then sent to a second handler, and the credit amount is transferred from the temporary stored value fund to the second handler.

Of note, claim 10 specifically provides for a *temporary stored value fund managed internally by the online system*. The specification discloses that the information pertaining to the money credit in the stored value fund is maintained within the user database. Application at p. 7, ll. 26-28. Claim 21 provides for a situation where *at least two different types*

second handlers are available. The specification discloses that the "[m]oney is transferred between the online money transfer system and the handler of the user's choosing. . . . Money could be in any currency, or be anything of monetary value, for example, airline mileage, promotional program points, gift certificate credit, commodities such as gold, etc." Id. at p. 3, ll. 7-14.

Missing Limitation: Stored Value Fund Managed Internally

In stark contrast to claim 10, Doggett does not disclose any method for maintaining an internally managed temporary stored value fund. Rather, Doggett discloses a method for "effecting a transfer of funds from an account of a payer in a funds-holding institution to a payee..." Doggett at p.18, col. 3, ll. 4-6. This method interfaces with a third party database, for "interbank clearing of checks," such as the Automated Clearing House. Id. at p.19, col. 6, ll. 6-7.

As understood by the Applicants, the Office Action takes the position that the Automated Clearing House functions as a temporary stored value fund, an intermediary between the funds being credited to the payee, and debited to the payor. As stated in Doggett, the Federal Reserve's Automated Clearing House "receiv[es] a transaction over the network and then split[s] and rout[es] the debit and credit portions of the transaction to the payer's and payee's banks." Id. at p. 17, col. 2, ll. 20-26. With all due respect, Claim 10 recites a stored value account that is configured in an entirely different fashion. Here, a stored value fund is maintained internally by the online system and remains in place as long as the payee or payor has credit remaining within the stored value account on the online system. After money is paid-in by a payor, the "[m]oney is a credit amount stored as a database entry corresponding to the user." Application at p.3, ll 1-9. "This database entry corresponds to the stored value fund for that user..." Id. at p.3, ll. 9-11. While in Doggett, the clearing house is run by a third party to route data and never has money stored within it, in contrast, a fund is maintained internal to the online system to store value in the claimed invention.

Hence, Applicants respectfully request reconsideration and withdrawal of the rejection as to claim 10 and the associated dependent claims 11-19. Applicants believe Doggett

does not teach the ability for the use of an internally managed temporary stored value fund. Having this ability allows for economical storage of credit between the time of pay-in by the payor and pay-out to the payee in one embodiment. Doggett does not teach this ability.

Missing Limitation: Stored Value with Multiple Handler Types

Also, in stark contrast to claim 21, Doggett does not disclose any method for accommodating multiple types of second handlers. Rather, Doggett discloses a method for "effecting a *transfer of funds* from an *account* of a payer in a *funds-holding* institution." Doggett at p.18, col. 3, ll. 4-6 (emphasis added). Here, the transaction data of the payor is verified by "the institution which holds an account of the payee..." Id. at p.18, col. 3, ll. 43-45.

As understood by the Applicants, the Office Action takes the position that Doggett teaches that credit amounts can be transferred from a stored value fund to a second handler. However, here, claim 21 requires that multiple forms of second handlers be available. Doggett does not teach the ability to effectuate pay-out in the form of alternative sources of value, such as airline miles, or promotional program points. While credit pay-outs under Doggett are based on secured funds held by an institution such as a bank, Applicants' method can effectuate payout in a plurality of forms.

Hence, Applicant respectfully requests reconsideration and withdrawal of the rejection as to claim 21 and the associated dependent claim 22. Applicants believe Doggett does not teach any method for accommodating multiple types of second handlers. Having this ability allows for convenient and efficient pay-out to the payee in whichever form the payee, or in some instances, the payor, requests. Doggett does not teach this ability.

Therefore, the rejected claims 10-14 and 16-23 are not anticipated by Doggett. Independent claims 10 and 21 and their associated dependent claims are believed to distinguish over Doggett because limitations in these claims are neither taught nor suggested by Doggett. Reconsideration of these rejections is respectfully requested.

35 U.S.C. §103 Rejection, Doggett et al. in view of Bator et al.

The Office Action has rejected claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,677,955 to Doggett et al. (hereinafter "Doggett") in view of the cited portions of U.S. Patent No. 6,575,362 to Bator (hereinafter "Bator"). Applicants believe the cited sections of Doggett, and the cited sections of Bator do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, neither of Doggett or Bator teach or suggest using a plurality of first handlers as required by claims 1, and dependent claims 2-8. For least this reason, Applicants respectfully request for reconsideration of the rejection to the claims.

Bator teaches a system which is "capable of quickly and efficiently generating and issuing money orders..." Bator at p.4, col. 2, ll. 65-66. Payment in through Bator is accomplished by "drawing funds directly from a customer's bank account, by drawing funds from a smart card, or by accepting currency through a bill acceptor." Id. at p.6, col. 5, ll. 15-17.

Missing Limitation: Multiple Handler Forms

Claim 1, and dependent claims 2-8 require that multiple forms of first handlers be available. None of the references cited contemplate the use of multiple forms of first handlers to accommodate a wide variety of money handlers. Just as in Doggett, the method of Bator does not accommodate multiple types of money in pay-in to the first handler (which, in Bator, would typically be the kiosk), such as airline miles, or commodities. Applicants believe that reliance upon Bator or Doggett to teach multiple forms of first handlers is not reasonably supported.

Motive for Combining Not Properly Set Forth

Further, Applicants note that while Doggett is referenced for the motivation to combine with Bator, no cite is given. Office Action, p. 12, last paragraph. Because there is no cite, it is unclear to the Applicants where the motivation to combine comes from. Applicants are unclear on how Doggett suggests the motivation and respectfully ask for a cite within Doggett which discloses the motivation to combine. The only way this combination of Bator and Doggett make any sense is to use the Applicants' claims as a template, which is impermissible hindsight

reconstruction. Under KSR Int'l. Co., v. Teleflex, Inc., when determining obviousness, there must be "an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." Specific reasons for the motivation relevant to the claimed limitations is respectfully requested in any further office action.

For at least the above reasons, Applicants do not believe that either Doggett or Bator teach the use of multiple types of first handlers, not is it obvious to combine money orders into an online stored value fund. Reconsideration is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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